

Amendments to the Drawings

Included with this Amendment are six (6) replacement sheets collectively comprising Figures 1, 2, 3-A, 3-B, 4, 5-A, and 5-B. These six (6) replacement sheets shall replace all five (5) previously submitted sheets also collectively comprising Figures 1, 2, 3-A, 3-B, 4, 5-A, and 5-B. In addition, five (5) annotated sheets showing the amendments to the drawings are included for reference.

Attachment: 6 Replacement Sheets
 5 Annotated Sheet Showing Changes

REMARKS / ARGUMENTS

This Amendment is submitted in full response to the Office Action dated August 10, 2006, wherein claims 7-11 were deemed to have been withdrawn from further consideration as being drawn to a non-elected species, claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,444,946¹ to Zeigler ("Zeigler"), claim 5 was rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,314,976 to Clarke ("Clarke"), and further claims 1 and 4-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,911,493 to Walker et al. ("Walker") in view of U.S. Patent No. 5,069,410 to McKee ("McKee"). Moreover, claims 2-3 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Further, as the PTO stated in the above-noted Office Action, independent claim 12 was allowed.

In addition, the drawings were objected to under 37 C.F.R. §§1.84(p)(4), 1.84(h)(1), 1.84(m), and 1.83(a)..

As explained hereunder, the outstanding rejections of the

¹ Applicant respectfully notes that the PTO referred to Ziegler as U.S. Patent No. 5,444,956 on page 5 of the Office action, rather than U.S. Patent No. 5,444,946 as correctly indicated on the Notice of References Cited attached thereto.

claims based on the cited prior art as applied by the U.S. Patent & Trademark Office ("PTO") are hereby traversed in full. In view of the foregoing amendments to the claims and the following remarks, Applicant respectfully requests the PTO's conscientious reconsideration of the same.

A. Objections to the Drawings

1. Objections to the Drawings Under 37 C.F.R. §1.84(p)(4)

As set forth in the above-noted Office Action, the PTO objected to the drawings as failing to comply with 37 C.F.R. §1.84(p)(4) because the designation of the reference characters "12", "32", and "20" are confusing since each of them designate more than one element. Specifically, the PTO states that (i) the reference character "12" has been used to designate both an "upper portion" (see Figs. 2 and 3A) and "a band" (see Fig. 3B), (ii) the reference character "32" has been used to designate both a "lower ledge of a ring" and an "upper ledge of the lower portion of the hub," and (iii) the reference characters "30" and "20" have both been used to designate "a channel." Each of these will be discussed in turn below.

First, with reference to (i) above, Applicant respectfully notes that reference character "12" is used uniformly throughout

the specification and the drawings to designate an "upper portion". In particular, this is true in the three drawings that the PTO has specifically referenced, namely, Figs. 2, 3A, and 3B. In support of this, at page 12, lines 3-5, referring to Fig. 3-A, it states: "ideally, the channel 30 is formed at or near the *upper portion* 12 thereof." Further, at page 13, lines 11-15, it states: "with reference now to Fig. 3-B, the hub assembly 10 can be formed to have an *upper portion* 12 that is separate and distinct from the lower portion 14, and as such, this embodiment may be termed a 'split' hub assembly." As further stated on page 14, lines 9-10, still referring to the embodiment illustrated in Fig. 3-B, "a band 20 can be included within the channel." Accordingly, reference character "12" as originally illustrated in Figs. 2, 3-A, and 3-B is uniformly used to designate an "upper portion," however, in accordance with the outstanding Office Action, and as discussed below, Replacement Sheets have been attached hereto to more clearly illustrate Applicant's novel invention. More in particular, Fig. 4 has been amended herein to more accurately identify the upper portion 12.

Second, Fig. 3-B, as amended herein, now correctly

illustrates the "upper ledge" as designated by reference character 34, and the "lower ledge" as designated by reference character 32. In addition, Fig. 3-B has been amended to include the reference character 20 to designate the band, which is uniformly represented in the Figures and discussed in the disclosure.

Third, with reference to Figs. 2 and 4, the PTO contends that reference characters "30" (in Fig. 2) and "20" (in Fig. 4) are both used to designate "a channel." Applicant respectfully notes, however, that reference character "30" as used in the specification and as illustrated in the Figs., including Fig. 2, designates a "channel," whereas character "20" as used in the specification and as illustrated in the Figs., including Fig. 4, designates a "band" which can be wrapped around the hub assembly or preferably within the channel 30. (See page 12, lines 15-18).

2. Objections to the Drawings Under 37 C.F.R. §1.84(h)(1)

As set forth above, the PTO further objected to the drawings under 37 C.F.R. §1.84(h)(1) because of the exploded view in Fig. 2 where the separate parts within the same figure should be embraced by a bracket or a lead line in order to show

the relationship or order of assembly of various parts.

As disclosed on page 8 of the present application, and as shown in Figure 2, the secondary hub member 18 is provided with a central cavity 19 extending axially there through for receiving the top end 140 of the pole 120. Further, as disclosed on pages 7-8, the hub member 10 may have a central cavity or aperture 15 extending there through for placement about a central pole member 120 and is slid able between the top 140 and bottom 160 ends of the pole member. Accordingly, Fig. 2, as presented in the attached Replacement Sheets, has been amended herein to include a lead line to designate the relationship of the main hub member 10 and the secondary hub member 18 relative to a pole member 120 (not shown in Figure 2).

3. Objections to the Drawings Under 37 C.F.R. §1.84(m)

Further, as set forth above, the drawings are objected to as failing to comply with 37 C.F.R. §1.84(m) because the solid black shading is not permitted. Accordingly, six (6) Replacement Sheets are attached hereto which more clearly depict Applicant's novel invention without any solid black shading.

4. Objections to the Drawings Under 37 C.F.R. §1.83(a)

As previously set forth herein, the PTO objected to the

drawings under 37 C.F.R. §1.83(a) as failing to show every feature of the invention specified in the claims. Further, the PTO stated that the feature "said brackets secured to said band and hub member" (claim 6) must be shown or the feature cancelled from the claim. Applicant respectfully notes that the feature recited in claim 6 is shown and illustrated in Figure 4 of the present application. Specifically, referring to page 11, lines 5-7 of the present application, it states that "in at least one embodiment, and as illustrated in Figure 4, the hub member 10 of the present invention also includes a band 20."

Accordingly, Applicant respectfully believes that Figure 4 clearly illustrates a bracket member 40 secured to the band 20 and the hub member 10, as recited in claim 6 of the present application. If, however, the PTO believes that an additional Figure would be appropriate to either illustrate a closer perspective of the feature presented in claim 6, or for any other reason, then Applicant will respectfully provide the same.

B. Election/Restriction Rejection

As set forth in the above-noted Office Action, the PTO contends that claims 7-11, as originally submitted, are drawn to a non-elected species, and as such claims 7-11 are withdrawn

from further consideration. Accordingly, claims 7-11 have been withdrawn herein.

C. Examiner Interviews

Applicant would like to thank the Examiner for the telephone interviews respectfully conducted on November 17, 2006 and December 7, 2006 with the Applicant's attorney. It is respectfully noted that matters discussed therein included the outstanding Office Action dated August 10, 2006, the cited references to Zeigler, Clarke, and Walker, Applicant's originally submitted and proposed Figures and claims, as well as Examiner's request to claim a hub assembly "in combination with an umbrella frame" in claims 1 and 14, as now fully presented herein.

Further, during said telephone conference of November 17, 2006, the Examiner took the position that a "better drawing" illustrating the "band" of Applicant's invention should be presented. Accordingly, on December 7, 2006, the Applicant's representative presented Examiner with a set of proposed revised drawings illustrating Applicant's novel invention for consideration during said telephone conference of December 7, 2006 with Applicant's attorney.

D. Legal Issues Involved with 35 U.S.C. 102 and 103

Before reviewing the substantive issues with regard to the rejection of the claims under 35 U.S.C. Section 102, the Applicant respectfully points out the well established requirement that:

For a prior art reference to anticipate in terms of 35 U.S.C. §102, **every** element of the claimed invention must be **identically** shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added).

Moreover, this burden on the U.S. PTO is further compounded by the fact that the Federal Circuit has stated that within the single reference:

[t]he identical invention must be shown in as complete detail as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

And, more recently, the Federal Circuit has further expanded this principle to include that:

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed

element is not present or is not identically disclosed in complete detail in the prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 of each claim comprising that element have been overcome.

Furthermore, once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO can not merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the decisions of the Federal Circuit instruct that:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facia case of obviousness based upon the prior art [and further that] the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Recently, this point was further emphasized by the Federal Circuit, which added that:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness. In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718, 63 USPQ2d 1031, 1037 (Fed. Cir. 2002); citing In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

E. 35 U.S.C. 102 Claim Rejections Based Upon Zeigler

As set forth above, original claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by Zeigler because the PTO's initial position is that Zeigler shows and teaches a hub assembly comprising a hub member having a central aperture (199), the hub member having an upper portion (149) and a lower portion (151), a channel (157) formed around the hub member, a band disposed in the channel, and a plurality of brackets (147, 169) pivotally secured to the band and the hub member for pivotally receiving an end of the strut member (79).

A careful review of the Zeigler reference, however, clearly indicates that the patented invention cannot be said to anticipate independent claim 1 of the present invention. From the above cited case law, it is well settled that to maintain a rejection under 35 U.S.C 102, every element of the claimed invention must be identically shown in a single reference and each claimed element must be shown in as complete detail as is

contained in the patent claim.

To begin, in accordance with Examiner's comments, Applicant has respectfully amended independent claim 1 herein to recite "a hub assembly in combination with an umbrella frame having a pole member."

Further, as amended herein, independent claim 1 of the present invention calls for a hub member movably mounted on the pole member of the umbrella frame and slidable along a length of the pole member between a bottom end and a top end thereof. Applicant respectfully notes that the hub (97) as disclosed in Zeigler, is clearly not movably mounted on a pole member, nor is it slidable along the length of a pole member or the outer portion (101). Rather, column 8, lines 53-57 of the specification in Zeigler states that "when the top half 149 and the bottom half 151 are fastened together ... the hub 97 is secured in position relative to the outer portion 101 by the pin 197 clamped in the grooves 203 between the mating faces 153 and 155."

Second, Examiner states that Zeigler discloses a channel (157) formed around the hub member, and a band disposed in the channel. However, column 7, lines 20-38, of Zeigler discloses

grooves (157, 159) formed on the mating faces (153, 155) of the top half (149) and the bottom half (151), wherein a ring (163) is clamped between the mating faces (153, 155) and in the grooves (157, 159). Importantly, Zeigler does not disclose, or even remotely suggest, "a band secured about an exterior peripheral surface" of the hub member as recited in currently amended independent claim 1 of the present application. Specifically, the ring (163) disclosed in Zeigler is disposed within the confines of the hub (97) such that in order to access the ring (163) from an external position, the hub (97) includes slots (145).

As such, there are numerous elements of the claimed invention that are not identically shown, or even remotely suggested, in Zeigler. Consequently, it is clear that the Zeigler reference is not an adequate basis for maintaining a rejection of the above noted claims under 35 U.S.C 102.

F. 35 U.S.C. 102 Claim Rejections Based Upon Clarke

As set forth above, original claim 5 stands rejected under 35 U.S.C. 102(b) as being anticipated by Clarke, based on the PTO's initial position that Clarke shows and teaches a hub assembly comprising, among other elements, a central aperture

(20) sized to receive a pole (12), an upper portion, a lower portion, and a waist (28) disposed between the upper and lower portions, the waist portion having a diameter smaller than the upper and lower portions, a channel (48) formed between the upper and lower portions and having at least one ledge (46) extending about a periphery of the hub member, and a plurality of brackets (52) secured to the channel of the hub member by fasteners (54).

Applicant notes that Clarke discloses two hub members, a one piece, upper or secondary hub member (30) maintained at the top end of the pole member (12) and a one piece main hub member (18) which is movable up and down the pole member (12). Accordingly, it is abundantly clear that the secondary hub (30) does not define an upper portion of the main hub member 18 but is an independent component of the Clarke hub assembly. In addition, the main hub member (30), as disclosed in Figure 3 of Clarke, includes an upper portion (24), a lower portion (26) and a waist portion (28), which are represented as being of a one piece construction.

Accordingly, Clarke clearly does not disclose, teach, or even remotely suggest a hub member having an upper portion 12

and a lower portion 14 being separate from one another and structured such that in an assembled orientation, the upper portion 12 and the lower portion 14 collectively form a channel 30 between them defined by at least one ledge (32 or 34) extending substantially continuously about an exterior periphery of the hub member, as recited in currently amended independent claim 5, and as illustrated in Figure 3. of the present application.

Rather, the cited reference to Clarke includes slots (42) including a base (46), a back wall (48) and a pair of side walls (50), such that the hub connector joints (52) are insertable therein.

Therefore, for the reasons described in detail above, the cited reference to Clarke does not specifically disclose or even remotely suggest specific structural features of Applicant's invention as now defined in the claims presented in this application by virtue of this amendment.

G. 35 U.S.C. 103 Claim Rejections

As set forth above, claims 1 and 4-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Walker in view of McKee. More specifically, the PTO's initial position is that

Walker discloses a hub member (14) being capable of sliding between a bottom end and a top end of a pole (12). Further, the PTO acknowledges that Walker does not disclose a hub assembly having a band secured about the periphery of the hub member and a plurality of brackets secured on the band, as defined in Applicant's claimed invention. In order to attempt to over come this recognized deficiency in the Walker reference, the Examiner relies on McKee in allegedly teaching a device comprising a band (100) secured on a periphery of a tubular member (36) and a plurality of brackets being secured on the band.

To begin, in addition to the band secured about the periphery of the hub member, Applicant respectfully notes that the invention disclosed in Walker does not teach or suggest a hub member being capable of sliding between a bottom end and a top end of the pole member. Specifically, Walker discloses a pole (12) and a hub (14), however, as stated in column 1, lines 66-67 in Walker, the hub (14) "is fixed to the upper end of the pole 12." Additionally, with reference to Figure 1 and column 2, lines 18-20, the invention disclosed by Walker requires a cap (28) pressed into an open upper end of the cavity within the hub (14) to close it off. As such, the hub (14) is explicitly and

clearly incapable of sliding between a bottom end and a top end of the pole (12).

Even if, however, it can be said that Walker does disclose the limitations of the claimed invention as stated by the PTO except for the band secured about the periphery of the hub member, a position Applicant respectfully and eagerly opposes, Applicant further submits that McKee can not be relied upon as a rejection of the claims of the present application. The McKee reference is directed to a mount for a support bracket for a mirror and as such relates to non-analogous art. Therefore, Applicant contends that an artisan, skilled in the art of umbrella frames and the components associated therewith, would not consider a support bracket for a vehicle mirror as being pertinent to a hub assembly for an umbrella.

In addition and as set forth above, it is well settled in the case law that hindsight knowledge of Applicant's invention to defeat patentability is prohibited. To the contrary the Examiner must show a motivation to combine the references relied on to create the case of obviousness, without reliance on such hindsight knowledge. As set forth above, the cited reference to McKee is directed to a mount for attaching a mirror support

bracket to the fender of a vehicle. Consequently, Examiner has not shown or even suggested a motivation to combine the cited, reference to Walker with the cited, non-analogous, reference to McKee to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully contends that the references to Walker and McKee represent an invalid combination to support an obviousness rejection under 35 U.S.C. Section 103(a).

Further, Applicant respectfully argues that McKee does not disclose, teach, or even remotely suggest, a plurality of brackets secured to a hub member, as recited in independent claims 1 and 5 of the present application. Rather, McKee discloses a sleeve (100) extending along the leg (36) from the floor (34) to the top opening of the cylindrical aperture. It is clear from the disclosure of the McKee reference that there are no brackets secured to the sleeve (100), rather, as Examiner has acknowledged in the pending Office Action, the sleeve (100) is structured to merely increase the frictional resistance between the leg (36) and portions (30, 32) of the mount 10. Accordingly, absent any frictional force that the sleeve (100) may provide, the sleeve (100) may move or rotate independently of the cover member (22) and the base member (12).

As such, Applicant respectfully asserts that claims 1 and 4-6 contained herein are clearly distinguishable from the Walker or McKee references, whether considered either singularly or in combination.

H. New Claim(s)

In the outstanding Office Action, the PTO stated that claims 2-3 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, new claim 13 as presented herein comprises the recitation of original, independent claim 1 with that of claim 2, which is indicated as containing allowable subject matter. Claim 3 has been amended to change its dependency to newly submitted claim 13. As such, it is believed that newly submitted independent claim 13 and all claims dependent thereon are in condition for immediate allowance.

In addition, contained herein is newly submitted independent claim 14 and claims 15-22 dependent thereon. Independent claim 14 recites a hub assembly in combination with an umbrella frame having a pole member. Further, independent claim 14 comprises a continuous channel disposed on said hub

member and extending about an exterior periphery thereof. In addition, a plurality of brackets are recited as being disposed within said channel and connected to the hub member. Further, the recited structural features contained in newly submitted independent claim 14 are not disclosed or suggested in any of the references in the prior art, whether considered alone or in combination.

As a final matter, the subject matter recited in new independent claim 14, as well as claims 15-22, is fully supported by the disclosure of the specification of the present application, and does not incorporate any new matter. For example, page 4, lines 2-5 of the present application states that "the present invention also contemplates an embodiment of the hub member which includes the channel but not the band secured thereto."

I. Conclusion

Based on the foregoing remarks, as well as the above amendments to the claims, it is respectfully requested that this application be given full and favorable reconsideration. It is believed that upon doing so, this application should be deemed to now be in condition for allowance, which action is also

Application No. 10/748,755
Amdt. dated December 11, 2006
Reply to Office Action dated August 10, 2006

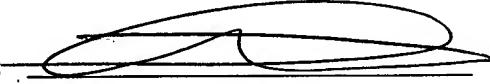
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respectfully requested.

In addition, a request for an appropriate extension of time is enclosed herewith along with the corresponding PTO fee. In the event that any additional fee may be required by the filing of this paper, the Commissioner is hereby authorized to charge any fees and/or credits to our **Deposit Account No. 13-1227.**

Respectfully Submitted,

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Annotated Sheet Showing Changes

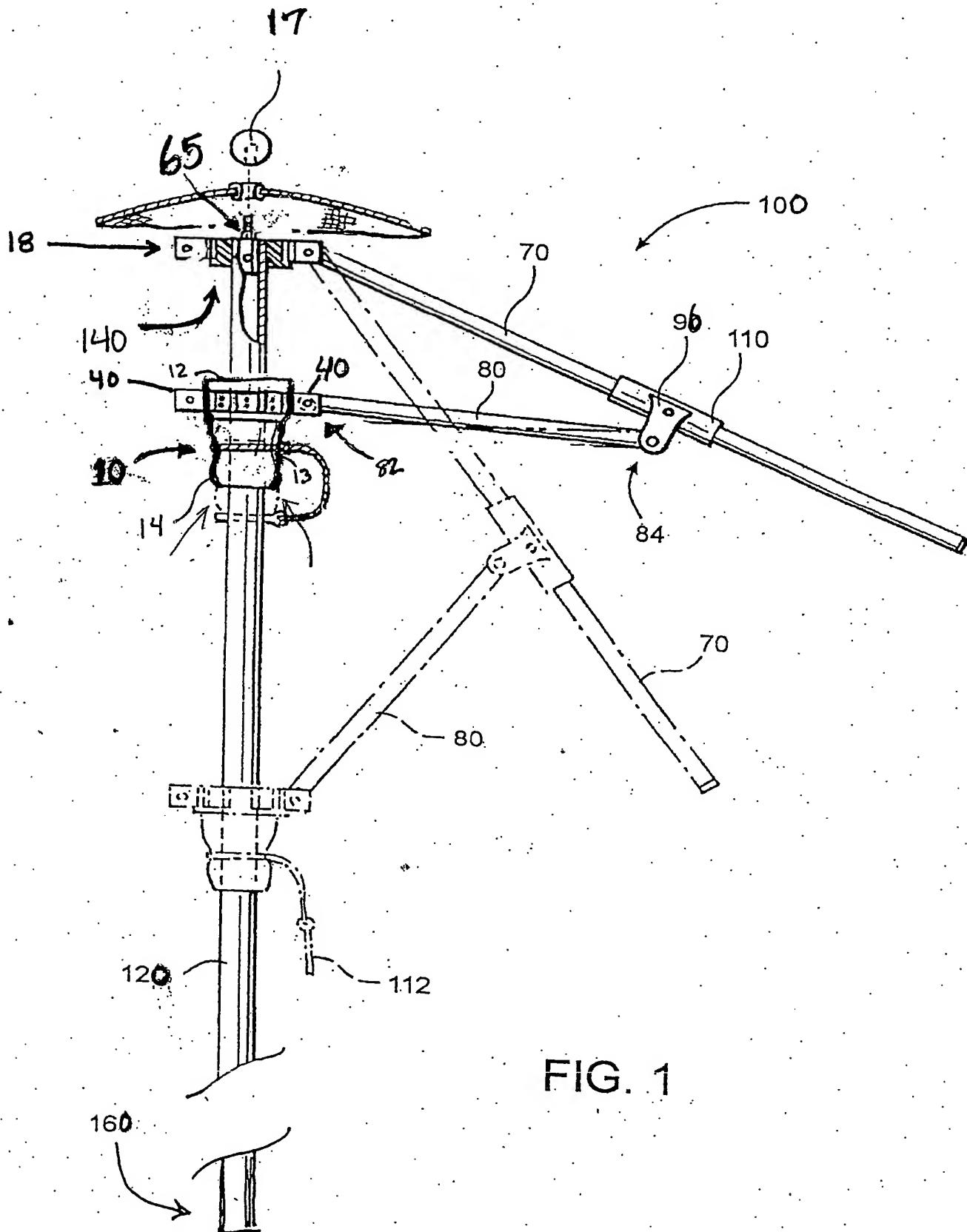


FIG. 1

